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REMARKS/ARGUMENTS

Claims 1-49 stand rejected in the outstanding Official Action. Claims 1, 15, 17, 19, 31, 32, 34, 35, 39-41, 43 and 44 have been amended and therefore claims 1-49 remain in the application.

The Examiner's indication of the acceptance of Applicants' originally filed formal drawings is very much appreciated.

The Examiner's withdrawal of the objections to the specification based on use of trademarks is very much appreciated. Additionally, the withdrawal of the rejection of claims 18, 33 and 42 previously rejected under 35 USC §101 is also appreciated. However, Applicants also amended claims 34 and 43 to recite hardware, but the Examiner finds that this recitation still relates to a non-functional arrangement of data.

Applicants have further modified claims 34 and 43 in the present amendment to recite a computer program product comprising a computer readable medium containing computer readable instructions that when executed perform the method steps of the reduced model as set out in claims 1 and 35, respectively. It is noted that similar language has been indicated as acceptable by the U.S. PTO in numerous patent applications and specifically in issued U.S. Patent 6,836,860 and is believed to meet the requirements of 35 USC §101. Applicants' specification supports this modified language because, while in the present invention this programming may be hardwired or softwired, claims 34 and 43 are directed to the logic sequence of the reduced model as set forth in the independent claims. Thus, the amended language of claims 34 and 43 is believed to meet the requirements of 35 USC §101 and any further rejection thereunder is respectfully traversed.

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Claims 1-5, 12-14, 16-21, 28-30, 32-34, 35-37 and 41-43 stand rejected under 35 USC §102 as being anticipated by Gupte (U.S. Patent 5,903,475). In the Final Rejection, on page 6, the Examiner takes the position that the existing wording of the independent claims (using claim 1 as an example), the requirement of "recording, in response to a change, input signals to and output signal" does not expressly recite recording in response to a change in those signals.

In other words, the Examiner takes the position that the statement "recording, in response to a change, input signals to and output signals from said subsystem circuit . . ." is not limited to recording when changes to the input signals or output signals occur. Applicants respectfully traverse this contention, as one of ordinary skill in the art reading the second full sub-paragraph in claim 1 would clearly understand the statement "recording, in response to a change, input signals to and output signals from said subsystem circuit" and understand that the "change" would have to be in the signals

Applicants noted and the Examiner admits, Gupte does not respond to changes in the input signals or the output signals so as to accomplish the recording function at that time. In order to clarify, Applicants have amended each of the independent claims to now recite "recording input signals to and output signals from said subsystem circuit in response to changes in at least one of said input signals and said output signals" thereby clearly limiting the recording to be in response to "changes in at least one of said input signals and said output signals."

While the Examiner is of the opinion that the previous claim language has a distinction which is "not precisely reflected," there is clearly no doubt in the amended language. While Applicants do not believe this language is necessary, as the standard is what one of ordinary skill

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in the art would understand by reading the claims, Applicants offer the above amended language in order to terminate the prosecution of this application.

The basis for one of ordinary skill in the art's understanding of the original claim language meaning the same thing as Applicants' amended claim 1 is set out in the first two paragraphs of the description of embodiments on page 7 – also page 9, lines 1 and 2 and page 14, lines 1-4 of Applicants' originally filed specification. Specifically, this description refers to the Print On Change (POC) file and how that is used to record signals to produce a reduced model. Page 14, line 7 discusses that the POC file prints values in response to changes in either the input signals or the output signals and thus is used to generate an output file "containing stimuli and expected responses."

As a result of the original language and/or Applicants' amended language, the independent claims 1, 17, 19, 32, 35, 40, 41 and 44 all clearly and unequivocally define over the disclosure in the Gupte reference. Moreover, Gupte, because it is directed at best towards a periodic strobe and/or clock signal (as suggested in the Final Rejection), this teaching would lead one of ordinary skill in the art away from Applicants' invention which records the signals in response to changes in at least one of the signals.

While Applicants are of the belief that claims dependent on the above-mentioned independent claims are also clearly patentable over the Gupte reference by itself, there are some particular statements by the Examiner in the Final Rejection which should be specifically considered. In the paragraph bridging pages 7 and 8 regarding claim 4, the Examiner contends that the Gupte reference discloses the reduced model includes a rule having "an output signal time window within which a change in said output signal to a predetermined output signal value

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should occur to be indicative of correct operation." In support of this contention, the Examiner cites a passage from Gupte that states that simulators "extract output vectors every 20 ns on the signals pout, dav and dbus starting 19ns into the cycle." This states that in Gupte, sampling occurs at precisely 19 ns, 39 ns (20 ns later), 59 ns (40 ns later), etc. This specification of specific precise times at which sampling occurs is not the same as specifying "an output signal time window" as set out in Applicants' dependent claim 4. As a result, claim 4 is clearly not taught by the Gupte reference.

Claims 6-11, 22-27, 38 and 44-49 stand rejected under 35 USC §103 as unpatentable over Gupte as previously applied to independent claims 1 and 19. The Examiner's admission that Gupte "does not expressly teach using a strobe signal in the model to trigger sampling of a strobed output signal and verify the strobed output signal" is very much appreciated. In view of Applicants' reading of the original subject matter of the independent claims, as well as the amended language of the same claims, requires recording one of input signals or output signals to take place in response to a change in one of those signals, Gupte is believed to teach away from Applicants' claimed invention.

The Examiner's admission that Gupte "does disclose a strobe rule which samples selected signals at regular intervals and to compare the sampled values with known good values to verify that the output signal is correct" is very much appreciated. This sampling "at regular intervals" does not in any fashion disclose Applicants' "recording, in response to a change, input signals to and output signals from said subsystem circuit" as set out in previous claim 1 or "recording input signals to and output signals from said subsystem circuit in response to changes in at least one of said input signals and said output signals" (in Applicants' currently amended claim 1).

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Additionally, the Examiner apparently uses the argument that "the strobe rule of Gupte provides the same functionality as the limitations recited in claim 6" as an indication of the obviousness of Applicants' claim 6 subject matter. It has been well settled that similar functionality does not equate to obviousness. Even if Gupte accomplished the exact same result as does the presently claimed invention, it would not necessarily render the claimed invention obvious. For example, an adjustable crescent wrench as well as a box end wrench can both have the same functionality, i.e., can be used to tighten and loosen a nut. However, the box end wrench does not render obvious the construction of an adjustable crescent wrench and could not support and obviousness rejection. Thus, the allegation of obviousness of claim 6 and the related claims with respect to the Gupte reference by itself is simply unsupported by any evidence of record.

Additionally, the Examiner makes only a conclusory statement that "it would be obvious to a person of ordinary skill in the art at the time of Applicants' invention to modify the strobe rule of Gupte to sample strobed output signals in response to a strobe signal in the model" The Examiner provides no reason or basis for that fact, other than perhaps his final statement (in the paragraph bridging pages 12 and 13) that the combination "could be achieved by a rule that defines the relationship between a strobe signal and one or more strobed signals." (emphasis added). The fact that the combination "could be achieved" is a clear admission that there is no suggestion for that combination of features and since they are certainly not disclosed in the Gupte reference, there is simply no support for the Examiner's obviousness contention.

Because the rejection of claims 6-11, 22-27, 38 and 44-49 is based upon the Gupte reference, all of the above comments distinguishing the independent claims from the Gupte

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reference are herein incorporated by reference and clearly establish that these claims would not be considered obvious in view of the Gupte reference by one of ordinary skill in the art.

Claims 15, 31 and 39 stand rejected under 35 USC §103 as unpatentable over Gupte in view of Rostoker (U.S. Patent 5,544,067). The Examiner's admission that "Gupte does not expressly teach monitoring output signals other than at sampling points for that output signal" is very much appreciated. The Examiner alleges that Rostoker teaches monitoring output signals within various points. It is noted that Rostoker only teaches sampling at specific locations in the circuitry.

Applicants' claim 15, as will be readily understood by those of ordinary skill in the art and as discussed in Applicants' specification, relates to the **time of sampling** the output signal, rather than the location at which the output signal is sampled. As this misunderstanding of claim 15 is understandable given the language "sampling points," Applicants offer the above amendment to claims 15, 31 and 39 to recite "sampling instants" which clearly avoids the Gupte/Rostoker combination.

The Examiner's indication that he "does not contest Applicants' reading of the Gupte reference, but reiterates that the claim language 'recording, in response to a change, input signals . . . ' does not precisely correspond to Applicants' argument" is very much appreciated. It is believed that those having ordinary skill in the art reading claim 1 and the other independent claims would clearly understand what was meant. However, the above amendment to the independent claims clearly avoids any possible misunderstanding of the Gupte reference and therefore any further rejection of claims 15, 31 and 39 is respectfully traversed.

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Entry of the Amendment pursuant to 37 CFR 1.116 is respectfully requested

Entry of the above Amendment after Final is respectfully requested under the provisions of Rule 116. Applicants note that no new claims have been submitted for consideration and that no new matter has been added to any claim. While Applicants believe that the previous language of the independent claims clearly and distinctly, when read by one having ordinary skill in the art, defines over the Gupte reference, also believe that the minor change in the independent claim wording clearly distinguishes the Gupte reference. The fact that the Examiner has previously considered this wording and thoroughly explained this issue in the Final Rejection clearly avoids any "new issues" being raised which would require further consideration and/or search.

Finally, Applicants believe that the entry of the above amendments to the independent claims would place those claims in condition for allowance, especially in view of the Examiner's admission that Applicants' previous argument identifies a "potential deficiency in the Gupte reference." Entry of the amendment to the independent claims is appropriate, in the Examiner words, because it corrects a distinction which the Examiner contends "is not precisely reflected in the [previous] claim language." While reasonable people can differ as to whether the previous claim language did or did not reflect the distinction, there is no doubt that the amended claim language reflects that distinction, and as such, clearly places the independent claims in condition for allowance over the Gupte reference.

Applicants can understand the Examiner's argument with respect to claims 15, 31 and 39, although reading these claims to mean sampling point as a location would not be reasonable. The claim is directed to changes in at least one of "said output signals" and the output signal at any point in time is going to be the same regardless of the location of sampling. However, a

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literal reading of the claim does suggest some confusion as to what is meant by "sampling points" and Applicants believe the amendment to read "sampling instants" clarifies that confusion and, as noted above, clearly distinguishes these claims from the Gupte/Rostoker combination.

In view of the above, it is submitted that entry of these amendments places all independent claims and claims dependent thereon in condition for allowance, thereby obviating the need for pursuing an appeal in this case. Therefore, having met the criteria established by Rule 116, entry of the above amendment is respectfully requested.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-49 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicants' undersigned representative.

Respectfully submitted,

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